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OFFICE OF PETITIONS

In re Application of
Hsei et al.
Application No. 09/726,258
Filed: September 29, 2000
Attorney Docket No. 39766-0093 C1

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: DECISION GRANTING PTA REQUEST
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This decision by the Office is in response to applicants' "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(b)" filed on February 3, 2005 requesting that the Office review the PTA and determine whether the actual PTA is zero (0) days rather than the disclosed forty-seven (47) days.

Applicants request for reconsideration for PTA is **Granted**. The proper amount of PTA at the time of the mailing of the notice of allowance is ZERO (0) days.¹ The Office will adjust the PAIR calculation to reflect a value of zero days at the time of the mailing of the notice of allowance.

The applicants assert that the Office erred in providing applicants 115 days of PTA for the mailing of the non-final on September 17, 2004. The applicants assert that the period should have been measured from the date of the filing of the RCE rather than the date of the filing of the notice of appeal. Accordingly, applicants assert that overall the proper calculation is zero (0) days.

Applicants arguments are correct. The Office erred in the awarding of 115 days of delay by the Office for the Office's mailing of a non-final rejection on March 17, 2004. The Office notes that on December 22, 2004, applicants submitted an RCE application. The Office had four months from the date of the submission of the RCE to respond to the RCE without granting additional PTA. The Office did respond within the four month requirement and accordingly did meet the requirement under 37 CFR 1.702(a)(2). The Office notes that a 50 day Office delay in acting within the 14 month requirement under 37 CFR 1.702(a)(1). However, the fifty (50) day Office delay was reduced by the ninety (90) days applicant delay for the response filed on December 30, 2002. Accordingly, at the time of the mailing of the notice of allowance the proper determination

¹ Applicants errantly cited that the determination was in the issue notification letter. The Office notes that the determination was provide in the notice of allowance because the determination for the issue notification letter is mailed after the establishment of an issue date. This application at the time of the filing of this decision has not established an issue date.

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is zero ($50-90=0$).²

The Office notes that applicants also bring to the Office's attention the fact that a terminal disclaimer has been filed. The Office will continue to determine the PTA days even if a terminal disclaimer has been filed but the Office provide notice of the front of the patent that the amount of PTA is subject to the submission of a terminal disclaimer.

After the mailing of this decision, the application is being forwarded to the Office of Patent Publication for prompt issuance of the patent. The Office further notes that any delays beyond four months of the payment of the issue fee and all other requirements being satisfied will be provided in the issue notification letter which advises applicants of the date of issuance of the patent.

The Office notes that no fees will be assessed for the submission of the request for reconsideration of PTA. The Office thanks applicants for their good faith and candor in bringing the discrepancy to the attention of the Office.

Any questions concerning this decision should be directed to Kery Fries, Senior Legal Advisor, at 571-272-7757.

Kery Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

cc: adjusted PAIR calculation

²The Office wants to advise applicants that in order for applicants to receive a final positive PTA determination, the Office must have further delayed by a period of more than 40 days since applicants delay was 40 days greater than Office delay at the time of the mailing of the notice of allowance.